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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,756	02/19/2004	Jin Yong Kim	1740-000003/US	2072

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON, VA 20195

EXAMINER	
JUNG, DAVID YIUK	
ART UNIT	PAPER NUMBER
2434	
MAIL DATE	DELIVERY MODE
11/25/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/780,756	KIM ET AL.	
	Examiner	Art Unit	
	David Y. Jung	2434	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *29 August 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/28/2008;10/2/2008;10/27/2008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

CLAIMS PRESENTED

Claims 1-10 are presented.

Response to Arguments

Applicant's arguments filed have been fully considered but they are unpersuasive as to allowance of claims.

Applicant has argued that Memorex reference is not prior art. The content of Memorex reference is prior art. Memorex reference is not a research article; Memorex reference explains the art. Unless Applicant is arguing that the content (of Memorex reference) is not prior art (instead of merely referring to the publication date of Memorex article), Applicant's argument is not persuasive.

If Applicant is actually arguing that content of Memorex reference is not prior art, Applicant is referred to the cited passages of Memorex reference itself. The passages explain what is usually meant by "pre-pit." The use of pre-pit in such fashion (of Memorex reference) is a defining feature of DVD itself (which differs from CD in this way). Thus, the only way that Applicant would be persuasive is if DVD came of existence after the date of priority of this patent application. Therefore, Applicant is deemed to be unpersuasive at this moment on this issue of date.

As for the matter of prior art as a whole, upon further research and further consideration, claims 1-10 is deemed to be not found in the prior art. As specification of

this patent application 10/780756 (especially at pages 1-5) notes, the use of wobbled pre-pit is usually for tracking so as to effectuate playing of the DVD (and not for security). The use of pre-pit in such fashion was not prior art.

Conditionally Allowable Subject Matter

The subject matter of claims 1-10 are not found in the prior art. In the context of all other limitations of the claims, the use of pre-pit in such fashion was not taught or suggested by the prior art. The actual allowance would depend upon the results of further searching the art and analyzing by the USPTO.

CITED PRIOR ART

Applicant has cited Office Actions from foreign patent offices. Because there is no suitable translation of the claims, one cannot determine the applicability of that Action from foreign patent offices. Applicant is specially requested to assist the USPTO on this matter

CLAIM REJECTIONS

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Due to explanation from Applicant, this rejection has become necessary. Applicant stated that "pre-pit type" is not the pre-pit itself, but is "information." See Remarks section of Amendment. Information is not patentable. Information is not functional in the sense of MPEP 2106. USPTO personnel should determine whether the claimed nonfunctional descriptive material be given patentable weight. USPTO personnel must consider all claim limitations when determining patentability of an invention over the prior art. In re Gulack, 703 F.2d 1381, 1385, 217USPQ 401, 403-04 (Fed. Cir. 1983). USPTO personnel may not disregard claim limitations comprised of printed matter. See Gulack, 703 F.2d at 1384, 217 USPQ at 403; see also Diehr, 450 U.S. at 191, 209 USPQ at 10. However, USPTO personnel need not give patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate. See In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); In re Ngai, 367 F.3d 1336, 70 USPQ2d 1862 (Fed. Cir. 2004). For further guidance on the term "nonfunctional", please see MPEP 2106.

Regarding claims 1-10, the claimed invention is directed to non-statutory subject matter. Claims recite only perfunctory recitation of functional material (computer readable recording medium, etc.). Aside from this, the claims recite only nonfunctional descriptive material. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas,

stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See Diehr, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance.

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Points of Contact

Any response to this action should be mailed to:

Commissioner for Patents

Alexandria, VA 22313.

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Kambiz Zand whose telephone number is (571) 272-3811.

/David Y Jung/

Acting Examiner of Art Unit 2134

David Jung

David Jung

Patent Examiner

11/25/08